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In re Application of : Brockway, Robert John
Serial No. : 09/599,679
Filed : June 22, 2000
For : COMPACTOR WHEEL AXLE GUARD SYSTEM
Group Art No. : 3617
Examiner : Russell D. Stormer

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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Date: March 18, 2011

/Gregory V. Madden/
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**APPLICANT INTERVIEW SUMMARIES AND
RESPONSE TO EXAMINER INTERVIEW SUMMARY MAILED MARCH 1, 2011**

Dear Sir:

In view of the telephonic interviews conducted February 24, 2011, March 3, 2011, and March 8, 2011, and Responsive to the Examiner Interview Summary mailed March 1, 2011, Applicant submits the following summary.

APPLICANT INTERVIEW SUMMARIES**February 24, 2011**

On February 24, 2011, Gregory V. Madden (Reg. No. 64,528) contacted Examiner Russell Stormer via telephone to discuss the Examiner's proposed claim amendments. These new proposed claim amendments came to light during Attorney Timothy J. Ziolkowski's (Reg. No. 38,368) February 23, 2011 telephone discussion with Examiner Stormer's Director, Mr. David Talbott. During the February 24, 2011 conversation, the Examiner indicated that claims 1-8, 14, 15, 20, 23, 25, 29, 33, 34, and 36 were considered subject to potential interference with claims 1-10 of U.S. Pat. 5,687,799 (hereinafter "the '799 Patent"). The Examiner further indicated that claims 11-12, 16-19, and 35 would not be subject to interference with the claims of the '799 Patent. The Examiner suggested that Applicant amend the independent claims to include the subject matter of any of claims 11-12 and 16-19 if Applicant wished to proceed directly to allowance and to avoid potential interference proceedings with the '799 Patent. Mr. Madden did not agree to such amendments, and no agreement was reached. The Examiner further explained that prosecution would once again be suspended for an additional six-month period.

March 3, 2011

On March 3, 2011, a telephonic interview was conducted between Attorney Ziolkowski, Mr. Madden, Examiner Stormer, Director Talbott, Supervisory Examiner Joseph Morano, and Quality Assurance Specialist Stephen Meyer. During the interview, Examiner Stormer's previously-proposed amendments were discussed, and Examiner Stormer revealed that Applicant's claim 1 was no longer considered subject to interference with the claims of the '799 Patent. Examiner Stormer suggested that independent claims 6, 14, 23, 25, 33, 34, and 36 be amended to include subject matter from claim 1 deemed not to be subject to interference with the claims of the '799 Patent in order to avoid potential interference with the '799 Patent. However, Attorney Ziolkowski and Mr. Madden did not agree to such amendments, and thus no agreement was reached between the Applicant and the Office.

March 8, 2011

On March 8, 2011, Attorney Ziolkowski and Mr. Madden conducted a follow-up telephonic interview with Examiner Stormer and Supervisory Examiner Morano. Examiner Stormer presented proposed amendments to several independent claims so as to avoid a potential interference proceeding with the '799 Patent, but no agreement was reached between the parties.

Examiner Stormer did indicate that claim 36 was no longer considered subject to interference with the '799 Patent. Thus, in accordance with the numerous conversations conducted with the Examiner and his supervisor(s), Applicant believes that the current Office position is that claims 6-8, 14-15, 20, 23, 25, 29, 33, and 34 are subject to interference with the '799 Patent, while claims 1-5, 11-12, 16-19, 35, and 36 are not subject to potential interference with the '799 Patent.

As an agreement could not be reached regarding claim amendments, Attorney Ziolkowski informed Supervisory Examiner Morano that the Office should do what it deems necessary to keep this Application from further stagnation. If the Office believes that an interference should be invoked, then Applicant respectfully requests that it be done without further delay and unnecessary "suspensions." Examiners Morano and Stormer agreed that it should not take longer than two weeks from the March 8, 2011 interview. Accordingly, Applicant requests immediate withdrawal of the suspension.

REPLY TO EXAMINER INTERVIEW SUMMARY

In the Examiner Interview Summary mailed March 1, 2011, the Examiner not only detailed the February 24, 2011 discussion with Mr. Madden, but further stated that "[d]uring a telephone conversation between the Examiner's Director, Mr. David Talbott, and Mr. Timothy Ziolkowski on February 23, 2011, Mr. Ziolkowski revealed that the Applicant no longer wished to instigate an interference and instead hoped to advance the application to issue." *Examiner Interview Summary*, March 1, 2011, continuation sheet. Applicant disagrees with this statement and believes it inappropriate for the examiner to summarize a conversation that he was not a part of. More specifically, Attorney Ziolkowski's reason for contacting Director Talbott was not to "reveal" that Applicant no longer wished to instigate an interference, but instead to point out that the lengthy and protracted prosecution history of the present reissue application. Indeed, because of that delay, Mr. Ziolkowski suggested that interference is no longer practical. That is, Applicant's claims 30 and 31, which were essentially copied claims corresponding to claims 1 and 2 of the '799 patent, were previously cancelled. Throughout the entirety of prosecution, the Examiner only instigated interference on the basis of claims 30 and 31. In fact, Applicant had previously attempted to instigate interference on the basis of now-cancelled claim 28, but the Examiner repeatedly stated that claim 28 "does not set forth the same patentable invention" as that which is claimed in the '799 patent. *See Final Office Action*, September 13, 2001, p. 7 and *Office Action*, June 5, 2002, p. 7. Claim 28 was cancelled as well. It should be noted that claim 28 is substantially similar to Applicant's pending claim 1, with the exception of minor changes to

the claim language which directly correlated with claim language from claim 1 of the '799 patent. The Examiner asserted claim 1 as the count claim up until the last interview. Applicant was merely pointing out that previously the Examiner did not consider claim 28 the "same patentable invention" as claim 1 of the '799 patent. Thus, based on the lengthy file history and the Examiner's repeated refusal to instigate an interference with respect to claim 28, Applicant believed that pending claims 1-8, 14-15, 20, 23, 25, 29, 33, and 34 should not now (10 years later) be considered the same patentable invention as claim 1 of the '799 patent if the prosecution history is to maintain consistency. With claims 30 and 31 now cancelled, Attorney Ziolkowski was not "revealing" that the Applicant no longer wished to instigate an interference, but was instead pointing out that the prosecution history and the Examiner's previous statements seemed to make an interference impractical at this stage.

Furthermore, the Examiner stated that "the Examiner explained that the previous suspension of prosecution had expired on January 27, 2011, but that the suspension would be continued for another 6 months in order to stop any statutory periods and prevent inadvertent abandonment of the application." *Examiner Interview Summary*, supra. However, Applicant notes that it is not incumbent upon the Applicant to act after prosecution is suspended, as such suspension is implemented by the Examiner for the purposes of instigating an interference. Thus, there should be no "inadvertent abandonment" by the Applicant, as no statutory period is running against the Applicant. In fact, in the Examiner's July 26, 2010 Miscellaneous Communication, the Examiner stated that "all claims are now allowable," and that "due to a potential interference, *ex parte* prosecution is SUSPENDED FOR A PERIOD OF 6 MONTHS from the date of this letter." *Miscellaneous Communication*, July 26, 2010, p. 2. As all claims were considered allowable, Applicant was under no further statutory period(s) for reply and was awaiting a response from the Office. Accordingly, Applicant requests that the present reissue application be handled expeditiously without any additional suspension of prosecution so as to avoid any further undue delay and loss of patent term.

Respectfully submitted,

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